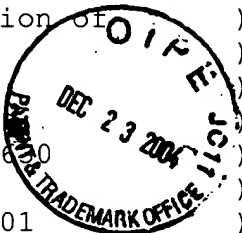


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of) Examiner: Arun Chakrabarti
Ming-Fong Lin) Art Unit: 1634
Serial No. 09/889,600) Our Ref.: UNMC.63131US
Filed: July 19, 2001)
For: "Therapeutic and)
Diagnostic Applications of)
Prostatic Acid Phosphatase)
In Prostate Cancer")



Attention: W. Gary Jones
Supervisory Patent Examiner, Technology Center 1600
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED DUE
TO OFFICE ERROR

Dear Sir:

A recent status check on the above-identified application revealed that this application became abandoned for failure to file a timely and proper reply to an action issued by the United States Patent and Trademark Office (USPTO). Applicant submits, however, that the reason for the failure to file a timely and proper reply is due to an error of the USPTO. The following facts are submitted in support of the Applicant's position.

A review of the file history of the above-identified patent application on the Patent Application Information Retrieval (PAIR) system reveals the error by the USPTO. A copy of the file history, as presented on PAIR, is submitted herewith as Exhibits A1 and A2. On March 19, 2003, the USPTO received a request for correspondence address change (Exhibit

B). This request for correspondence address change was entered into the above-identified patent application. However, the request for correspondence address change is clearly intended for a different patent application than the above-identified patent application. Indeed, the patent application number, the listed applicant, filing date, and title of the request are directed to a completely different patent application.

Due to this clearly erroneous address change, the Office Action that was mailed on October 9, 2002 (Exhibit C) was addressed to Stephanie Seidman of Heller Ehrman White & McAuliffe and not to the proper attorneys of record at Dann, Dorfman, Herrell & Skillman. Unfortunately, it appears that the recipients of the Office Action did not take appropriate measures to inform the USPTO of the erroneously mailed Office Action. Accordingly, the proper attorneys for Applicant never received the Office Action mailed on October 9, 2002.

As stated at MPEP §711.03(c) upon a sufficient showing of evidence, a holding of abandonment should be withdrawn based on the failure to receive an Office Action. Applicant submits that the above evidence is sufficient to prove that that the Office Action was not properly received.

Applicant hereby requests the revival of the above-identified patent application. Inasmuch as the abandonment occurred as a result of Patent Office error, Applicant submits that no fee should be required. Should Applicant be mistaken in this regard, the undersigned authorizes the Office to charge the deposit account of the undersigned 04-1406. Applicant respectfully requests the issuance of a new Office Action and that the Office Action be sent to the address of the proper attorneys of record at Dann, Dorfman, Herrell & Skillman.

Furthermore, as the delay in the issuing of a patent from the above-identified application is due to Office error,

Applicant will seek an adjustment in patent term pursuant to
35 U.S.C. §154.

Respectfully submitted,
DANN, DORFMAN, HERRELL AND SKILLMAN
A Professional Corporation

By


Kathleen D. Rigaut, Ph.D., J.D.
PTO Registration No. 43,047

Telephone: (215) 563-4100
Facsimile: (215) 563-4044
Enclosures: Exhibits A1, A2, B, and C

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United States Patent and Trademark Office

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PATENT APPLICATION INFORMATION RETRIEVAL

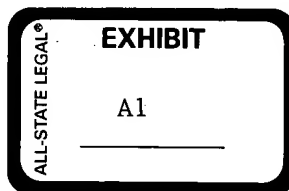


Search results as of: 11-19-2004::10:16:58 E.T.

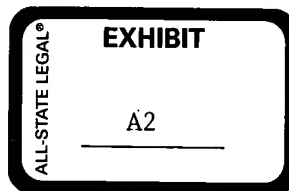
Search results for application number: 09/889,630			
	09/889,630		110
	07-19-2001		Abandoned -- Failure to Respond to an Office Action
	Utility		08-24-2003
Examiner Name:	CHAKRABARTI, ARUN K		ELECTRONIC
Group Art Unit:	1634	Location Date:	-
Confirmation Number:	7143	Earliest Publication No:	-
	UNMC.63131US	Earliest Publication Date:	-
	435/006		-
	Ming-Fong Lin, Omaha, NE		-
	Therapeutic and diagnostic applications of prostatic acid phosphatase in prostate cancer		

Search Options

Assignments
Continuity Data
Image File Wrapper



File History	
Date	Contents Description
09-15-2003	Correspondence Address Change
08-25-2003	Mail Abandonment for Failure to Respond to Office Action
08-24-2003	Abandonment for Failure to Respond to Office Action
10-09-2002	Mail Non-Final Rejection
09-30-2002	Non-Final Rejection
03-19-2002	Correspondence Address Change
09-30-2002	Date Forwarded to Examiner
03-05-2002	Response to Election / Restriction Filed
02-07-2002	Case Docketed to Examiner in GAU
01-24-2002	Information Disclosure Statement (IDS) Filed
01-22-2002	Mail Notice of Informal or Non-Responsive Amendment
01-10-2002	Date Forwarded to Examiner
10-22-2001	Informal or Non-Responsive Amendment after Examiner Action
10-22-2001	Response to Election / Restriction Filed
10-05-2001	Mail Restriction Requirement
10-05-2001	Requirement for Restriction / Election
10-05-2001	Case Docketed to Examiner in GAU
09-21-2001	Case Docketed to Examiner in GAU
09-05-2001	Application Dispatched from OIPE
08-31-2001	IFW Scan & PACR Auto Security Review
08-29-2001	Correspondence Address Change
08-21-2001	Released to OIPE
08-21-2001	Notice of DO/EO Acceptance Mailed
08-20-2001	371 Application Preexamination Docketing
08-20-2001	371 Application Preexamination Docketing
07-31-2001	371 Application Preexamination Docketing
07-19-2001	Receipt of 371 Request
07-31-2001	Correspondence Address Change
07-19-2001	Initial Exam Team nn





COPY OF PAPERS
ORIGINALLY FILED

1655
#8/CFR

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: CANTOR ET AL
Serial No.: 09/880988
Filed: JUNE 13, 2001
For: USE OF NUCLEOTIDE ANALOGS
IN THE ANALYSIS OF
OLIGONUCLEOTIDE MIXTURES
AND IN HIGHLY MULTIPLEXED
NUCLEIC ACID SEQUENCES
Examiner: CHAKRABARTI, A.
Art Unit: 1655

I hereby certify that this paper and the attached
papers are being deposited with the United
States Postal Service as first class mail in an
envelope addressed to:
Commissioner for Patents
Washington, D.C. 20231, on this date.

02/28/2002
Date

Alicia Bradbury
Alicia Bradbury

RECEIVED

MAR 22 2002

TECH CENTER 1600/2900

CHANGE OF ADDRESS

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

Please send all correspondence for this application to:

STEPHANIE L. SEIDMAN, ESQ.
HELLER EHRMAN WHITE & MCAULIFFE LLP
4350 LA JOLLA VILLAGE DRIVE, 7TH FLOOR
SAN DIEGO, CA 92122-1246

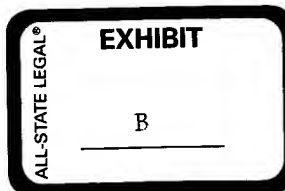
The telephone number is (858) 450-8400 and facsimile number is
(858) 587-5360.

Respectfully submitted,
HELLER EHRMAN WHITE & MCAULIFFE LLP

By:

Stephanie Seidman
Stephanie Seidman
Registration No. 33,779

Attorney Docket 25491-2408
Address all correspondence to:
HELLER EHRMAN WHITE & MCAULIFFE LLP
4350 La Jolla Village Drive, 7th Floor
San Diego, California 92122-1246
Telephone: (858) 450-8400
Facsimile: (858) 587-5360
E-mail: sseidman@HEWM.com





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,630	07/19/2001	Ming-Fong Lin	UNMC.63131US	7143

7590 10/09/2002

STEPHANIE L SEIDMAN
HELLER EHRMAN WHITE & MCAULIFFE
4350 LA JOLLA VILLAGE DRIVE 7TH FLOOR
SAN DIEGO, CA 92122-1246

EXAMINER

CHAKRABARTI, ARUN K

ART UNIT

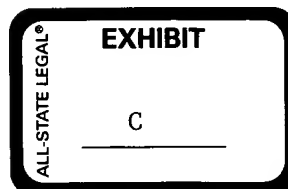
PAPER NUMBER

1634

DATE MAILED: 10/09/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/889,630

Applicant(s)

LIN, MING-FONG

Examiner

Arun Chakrabarti

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 22-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

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DETAILED ACTION

Specification

1. Applicant's election of claims 14-21 corresponding to Group III, without traverse, in Paper NO: 4, and CRF in Paper NO: 7 are hereby acknowledged. Applicant is hereby informed that the Paper NO:7 including amendment and CRF is still non-responsive to the office action (Paper NO:5) mailed on January 22, 2002 because the applicant inadvertently overlooked the requirement of a SEQ ID Number in claim 21. Appropriate correction and amendment is suggested.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is rejected over the recitation of the phrase, "Northern, and Southern". It is not clear if the Northern blot and Southern blot analysis (as mentioned in the specification, page 27, lines 7-8) are claimed or the Northern, and Southern directions are claimed or both of them are claimed. The metes and bounds of the claims are vague and indefinite.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provari et al. (Biochemical and Biophysical Research Communication, (August 24, 1995) (Vol. 213(3), pages 861-868) in view of Horoszewicz (U.S. Patent 5,763,202) (June 9, 1998).

Provari et al teach a method of determining the expression of cellular PAcP protein which is androgen-insensitive in the prostate (Abstract and Materials and Methods Section).

Provari et al teach a method, wherein the activity of cellular Pacp is quantified by measuring acid phosphatase activity and quantifying the concentration of cellular PacP mRNA by Northern blot analysis.(Figure 1 and Materials and Methods Section and Results section).

Provari et al do not teach a method, wherein prostate carcinoma is diagnosed comprising the step of determining the expression of cellular protein in the prostate carcinoma by quantifying a protein by an antibody immunologically specific to the cellular protein.

Horoszewicz teach a method, wherein prostate carcinoma is diagnosed comprising the step of determining the expression of cellular protein in the prostate carcinoma by quantifying a

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protein by an antibody immunologically specific to the cellular protein (Abstract and Tables 1 and 2 and claims 1-14 and Column 9, line 40 to column 24, line 17).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to substitute and combine, within the method of Provari et al., method wherein prostate carcinoma is diagnosed comprising the step of determining the expression of cellular protein in the prostate carcinoma by quantifying a protein by an antibody immunologically specific to the cellular protein of Horoszewicz since Horoszewicz states, "This invention relates to the production of and applications for monoclonal antibodies specific for prostatic tumor antigens. More particularly, this invention relates to monoclonal antibodies against non-soluble, membrane associated, organ specific determinants expressed maximally on human normal and neoplastic prostatic epithelium. Monoclonal antibodies capable of reacting with membrane associated surface antigens are of value for the immuno-classification and detection of disease and represent novel agents for immunotherapy (Column 1, lines 18-28)." An ordinary artisan would have been motivated to substitute and combine, within the method of Provari et al., method wherein prostate carcinoma is diagnosed comprising the step of determining the expression of cellular protein in the prostate carcinoma by quantifying a protein by an antibody immunologically specific to the cellular protein of Horoszewicz in order to achieve the express advantages, as noted by Horoszewicz, of monoclonal antibodies capable of reacting with membrane associated surface antigens which are of value for the immuno-classification and detection of disease and represent novel agents for immunotherapy and which

Art Unit: 1634

relates to the production of and applications for monoclonal antibodies specific for prostatic tumor antigens.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Provari et al. (Biochemical and Biophysical Research Communication, (August 24, 1995) (Vol. 213(3), pages 861-868) in view of Horoszewicz (U.S. Patent 5,763,202) (June 9, 1998) further in view of Ostanin et al. (The Journal of Biological Chemistry, (March 25, 1994) (Vol. 269(12), pages 8971-8978),

Provari et al. in view of Horoszewicz teach the method of claims 14-20 as described above including quantification of PacP mRNA by its specific hybridization to certain nucleic acid sequences.

Provari et al. in view of Horoszewicz do not teach the method, wherein the specific nucleic acid sequence is at least 15 consecutive nucleotides of M34840.

Ostanin et al. teach the method, wherein the specific nucleic acid sequence is at least 15 consecutive nucleotides of M34840 (Abstract and Page 8971, Column 1, second paragraph of the footnote).

It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to substitute and combine, within the method of Provari et al. in view of Horoszewicz, the method, wherein the specific nucleic acid sequence is at least 15 consecutive nucleotides of M34840 of Ostanin et al since Ostanin et al. state, "Because of its clinical importance as a prostate tumor marker, human prostatic acid phosphatase (hPAP) is the most

Art Unit: 1634

extensively studied of the high molecular weight acid phosphatases (Page 8971, Column 2, first sentence of the second paragraph)." An ordinary artisan would have been motivated to substitute and combine, within the method of Provari et al. in view of Horoszewicz, the method, wherein the specific nucleic acid sequence is at least 15 consecutive nucleotides of M34840 of Ostanin et al. in order to achieve the express advantages, as noted by Ostanin et al., of certain variants of human prostatic acid phosphatase (hPAP) which is the most extensively studied of the high molecular weight acid phosphatases because of its clinical importance as a prostate tumor marker.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group analyst Chantae Dessau whose telephone number is (703)605-1237.

Arun Chakrabarti,

Application/Control Number: 09/889,630

Page 7

Art Unit: 1634

Patent Examiner,

September 24, 2002


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600

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